

Application No.: 09/892,611
Pre-Appeal Brief Request for Review



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Hemant M. CHASKAR

Serial No.: 09/892,611

Filed: June 28, 2001

For: Protocol to Determine Optimal Target
Access Routers for Seamless IP-Level
Handover

Atty. Docket No.: 005288.00010

Group Art Unit: 2142

Examiner: Blair, Douglas B.

Confirmation No.:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Box AF

U.S. Patent and Trademark Office
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401 Dulany Street
Alexandria, VA 22314

I hereby certify that this correspondence is being
facsimile transmitted to the Patent and Trademark
Office on February 17, 2006, to (571) 273-8300.
Signature: n/a
Ross A. Dannenberg, Reg. No. 49,024

Sir:

Applicants respectfully request review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a Notice of Appeal. The review is requested for the reasons stated in the below remarks. If any fees are required or if an overpayment is made, the Commissioner is authorized to debit or credit our Deposit Account No. 19-0733, accordingly.

Remarks

Having received and reviewed the final Office Action dated September 21, 2005, and the Advisory Action dated January 9, 2006, Applicants respectfully submit that the standing rejections are based on one or more clear errors, and that the appeal process can be avoided through a pre-appeal brief review as set forth in the Official Gazette notice of July 12, 2005.

The pending rejections fail to address all the claim limitations, and exhibit clear factual and legal errors with respect to the cited references. The specific errors relied upon in this Pre-Appeal Brief Request for Review include the following:

- The Office made a clear factual error in its analysis of the cited prior art. As argued in the Response dated December 20, 2005 (page 2, near top), and in the Response dated June 28, 2005 (pp. 9-11), neither reference teaches or suggests the use of access routers as claimed.
- The Office made a clear legal error by misinterpreting the scope of the claims. The Office, in the Advisory Action, indicates that “given the scope of Applicant’s claims, the access point is considered an access router.” The Office does not indicate which access point to which it refers. If the Advisory Action is referring to the claimed access point, the claims clearly recite an “access point,” not an “access router,” and it is legally improper for the Examiner to unilaterally alter the claims by changing a claim limitation. If the Examiner instead is referring to the access point of the cited references, the scope of the claims would have no bearing on the interpretation of a prior art reference in the first place, and would therefore also be improper.
- The Office has made a clear factual error in its interpretation of the Rom reference, e.g., as previously argued in the Response dated December 20, 2005, p. 2, second full paragraph.
- The Office has made clear legal and factual errors by not addressing the features of the dependent claims, as previously argued.

While Applicants believe the above points represent the clearest errors made by the Office, Applicants reserve the right to appeal on other bases and errors. In addition, Applicants believe the rejections of other claims not identified above are also based on one or more Office errors. Applicants will address such issues on appeal should the appeal of this case proceed after the Office’s consideration of this paper.

CONCLUSION

All issues having been addressed, Applicants respectfully submit that the instant application is in condition for allowance, and respectfully solicit prompt notification of the same. However, if for any reason the review panel believes the application is not in condition for

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allowance or there are any questions, the review panel is invited to contact the undersigned at (202) 824-3153.

Respectfully submitted,

BANNER & WITCOFF, LTD.

Dated this 17th day of February, 2006

By:

A handwritten signature in black ink, appearing to read "Ross D.", followed by a horizontal line.

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